

REMARKS

Claims 1-15 are pending in the present application. Claims 16-26 were previously cancelled without prejudice. Applicant has added new claims 27-33 in this paper.

In a Non-Final Office Action dated August 5, 2009, the Examiner has made the actions further described below. Applicant respectfully traverses.

In addition, Applicant notes that the Examiner has stated on the "Office Action Summary" page that the instant Office Action is non-final. However, on Page 9 of the Office Action the Examiner then states, in Section 13, that "THIS ACTION IS MADE FINAL." Applicant believes that the Examiner unintentionally stated that the Office Action is Final on Page 9, and Applicant believes that the proper status of the instant Office Action is non-final and is replying accordingly.

Claim Rejections

Rejections Under 35 U.S.C. 101

The Examiner has rejected claims 1-8 as being assertedly directed to non-statutory subject matter.

In particular, the Examiner asserts that claim 1 fails, under *In re Bilski* (88 USPQ2d 1385), to be "tied to another statutory class (such as a particular apparatus)." However, the Examiner then implies that the claim is tied to statutory subject matter such as a server and host connection manager, but that the tie is "representative of extra-solution activity."

Applicant respectfully submits that that the Examiner misconstrues claim 1 in view of 35 U.S.C. 101 and relevant case law. Specifically, claim 1 recites steps that are clearly tied to a statutory class, including, at a minimum, a host connection manager, a client terminal, and a server. These elements, as well as their functionality with respect to the claim language are tied to the claim's functionality, and are not, as the Examiner asserts, merely "extra-solution activity."

For example, the presently claimed method recites steps that are specifically described as being performed by the various described elements, such as generating, at the host connection manager, a request for a PIN, transmitting the request to the server, and receiving the PIN at the host connection manager.

Various additional aspects of the method of claim 1 are tied to a statutory class. For example, claim 4 recites a PIN cache, which would inherently be in some sort of memory device, claims 5 and 6 recites use of first and second networks, and claim 7 recites a particular memory configuration of a client terminal wherein no PINS are stored therein.

Accordingly, Applicant respectfully submits that claim 1, as well as associated dependent claims 2-8, describe statutory subject matter for at least the reason that they are properly tied to another statutory class and the specifically described statutory subject matter does not merely constitute "extra-solution activity," but rather is clearly tied to the claims as presently written.

Rejections Under 35 U.S.C. § 112

The Examiner states that “claims 1-21 are rejected under 35 U.S.C. § 112” as being “incomplete for omitting essential steps amounting to a gap between the steps” [Office Action, Page 5, Item 4]. Applicant respectfully notes that claims 16 thru 26 were previously cancelled in this application and therefore only claims 1-15 (not 1-21 as stated by the Examiner) are pending.

With respect to claim 1, the Examiner states that “there is no process for generating the PIN.” Applicant submits that there is no need to describe, in particular in an independent claim such as claim 1, how a particular PIN is generated – the claim is directed to a method of distributing a PIN, not necessarily a method for generating one. Accordingly, Applicant further submits that the claim language is complete – the claim describes a host connection manager transmitting a request for a PIN to a server, and the host connection manager receiving, in response to the request, a PIN in reply. How or where the PIN is “generated” is not important to the language of claim 1 as presently written.

The Examiner further states that the language “a client request generated and transmitted from the client terminal . . .” is unclear. Specifically, the Examiner states that it is “unclear whether this is a new request or the request referred to in the previous step.”

Applicant submits that this language is clear. In particular, the previous step refers to a “request for a PIN,” whereas the step cited by the Examiner refers to “a client request generated and transmitted from the client terminal.” Applicant further notes the use of the word “a” preceding “client request,” rather than the use of the word “the.”

For at least the above-described reasons, Applicant respectfully submits that claim 1, as well as associated dependent claims 2-8, are proper under 35 U.S.C. § 112. Applicant therefore requests that the rejections be withdrawn and claims 1-8 be allowed.

With respect to claim 9-15, the Examiner has stated that they are also rejected under 35 U.S.C. § 112; however, the Examiner has provided no basis or arguments in support of the rejection of claims 9-15. If the Examiner believes these claims are improper, Applicant requests that the Examiner clearly provide an explanation as to why in a new, non-final Office Action.

Rejections Under 35 U.S.C. § 103

The Examiner has rejected claims 1-15 under 35 U.S.C. § 103(a) as being assertedly obvious over Brody et al. (United States Patent No. 5,350,906) in view of Konya (United States Patent No. 5,350,906).

Brody Disclosure

Brody is directed towards a currency transfer system and method using existing ATM networks while providing for temporary assignment of a PIN number and the temporary establishment of a credit limit within an existing account [Abstract]. The system of Brody describes providing a sub-account to an existing account, wherein a partial PIN is assigned to this sub-account, with a sender then required to generate a second half of the PIN, that may then be sent to a recipient to access money in the sub-account. [Col. 3, lines 5-10].

Differences Between Brody and the Present Invention

One aspect of the present invention as described in, for example, claims 1 and 9, as well as their associated dependent claims, relates to generation, at a host connection manager, of a request for a PIN, wherein the PIN is associated with a particular monetary value. The Examiner asserts that Brody teaches such an element, stating that Brody describes “generating, at a host connection manager, a request for a PIN, wherein the PIN is associated with a particular monetary value,” citing the Abstract of Brody.

In reply, Applicant first notes that a “host connection manager” is specifically described in the specification of the present application, as well as the figures (see, e.g., figures 20 and 21), as an element coupled between one or more client terminals and one or more server elements. Brody, on the other hand, neither describes nor suggests such a configuration, and in particular not in the Abstract as asserted by the Examiner. Specifically, the Abstract says absolutely nothing about the configuration of elements as is claimed, nor does any other section of Brody. Moreover, the Examiner has not described where, in Brody, he believes the specifically claimed elements and associated claimed configuration is described.

Another aspect of the present invention as is described in claims 1 and 9 relates to transmitting a request for a PIN from a host connection manager to a server and receiving a PIN at the host connection manager. The Examiner asserts that Brody describes such elements, citing Column 7, lines 14-24. This section of Brody (including lines 9-32 for context) reads:

The withdrawing party then inserts card 80 into any ATM machine, such as ATM machine 15 (FIG. 1) located at a location remote from ATM machine 14. This remote location could be in another state or perhaps even in another country.

In response to the normal prompts, the withdrawing party enters, via keypad 152, the PIN number communicated from the depositing party. The system, as will be seen, then processes the information and verifies the account number by sending the information to ATM Network Processing Central 12, which then in turn directs the information to database 10 of sponsor account A10. This sponsor account is the same sponsor account that was identified by deposit card 70 since the depositor and the withdrawer both dealt with a card issued by the same sponsor A10.

After verification of the PIN number, as reported back from account A10 as will be discussed, the withdrawer keys in the amount desired. If the amount is less than or equal to the amount in the sub-account, ATM machine 15, via currency dispenser 156, provides the currency requested. As will be discussed, withdrawal card 80 is then invalidated, or returned to the withdrawing party, depending upon the design of the system.

Contrary to the Examiner's assertion, Brody, Col. 7, lines 14-24 merely describe a customer inserting a card into an ATM and entering a PIN (as one would do in a typical ATM transaction). The cited section says absolutely nothing about a host connection manager as described in claims 1 and 9, or in particular about generating a request for a PIN from such an element or receiving a PIN based on such a request – the cited section of Brody specifically presumes that a user already has a PIN that is entered into the system and then verified. This is clearly described in Brody, Col. 6, lines 65 - Col. 7, line 2, which describe purchase of a “withdrawal card 80,” which is subsequently inserted into an ATM as described at Col. 7, lines 14-24. In summary, contrary to the Examiner's assertion, the cited section (Col. 7, lines 14-24), say absolutely nothing about transmitting a request for a PIN from a host connection manager to a server, and the Examiner has failed to describe any elements of Brody that he believes correspond to the specifically claimed elements performing the claimed steps.

In addition, Applicant is unable to identify any other section of Brody that describes a host connection manager or analogous element, or in particular generating a request for a PIN from such an element or receiving a PIN in response to such a request.

The Examiner further refers to figure 3, step 305, “read amount,” and figure 3, step 311 “send PIN.” However, these steps are clearly distinguished from the presently claimed elements. Specifically, step 305 relates to an ATM reading a “bought card” with a preprogrammed value, which has nothing to do with a host connection manager requesting a PIN from a server. Likewise, step 311 describes sending a PIN, balance and other data to an ATM processing network. If anything, what is described in Brody is the opposite of the claimed step. In particular, the claim language describes sending a request for a PIN to a server and subsequently receiving a PIN in reply, whereas Brody, at most, describes sending a PIN to an “ATM Network Processing Central” (which Applicant believes the Examiner may be analogizing the claimed server). In subsequent steps as shown in FIG. 3, Brody describes nothing about sending a PIN back in reply, nor does it describe such as step elsewhere.

Therefore, for at least these reasons, Applicant respectfully submits that the rejection of claim 1 and 9 under 35 U.S.C. § 103 are improper. Accordingly, Applicant requests that the rejections be withdrawn and claims 1 and 9, as well as their associated dependent claims, be allowed.

In addition, claims 1 and 9 relate to receiving, at a host connection manager, a client request indicative of the particular monetary value, wherein the client request is generated at the client terminal and transmitted to the host connection manager. The Examiner asserts that Brody describes such elements, citing Figure 3, step 305 “read amount” and step 311 “send PIN.” Applicant respectfully submits that the Examiner misconstrues this section of Brody. Specifically, Figure 3, step 305 shows the following:

(REPLACE AMOUNT ENTRY STATE)
READ AMOUNT PRE-ESTABLISHED ON SPONSOR CARD

Applicant fails to understand how this describes the step of receiving, at the host connection manager, a client request indicative of a particular monetary value. More particularly, Brody describes that Figure 3 is a process executed in an ATM machine (see, e.g., Brody Col. 10, lines 33-43), which would be analogous, at most, to a client terminal of the present invention, not to a host connection manager as is described in claims 1 and 9. Moreover, step 305 merely describes reading an amount pre-established on a sponsor’s card (see, e.g., Brody Col. 11, lines 31-33) – it does not describe anything about receiving a client request indicative of a particular monetary value, or in particular receiving such a request at a host connection manager.

Likewise, Applicant respectfully submits that the Examiner also misconstrues Brody Fig. 3, step 311. The Examiner asserts that step 311 shows sending the client request to the host connection manager: “(Figure 3 – step 311 send PIN).” Applicant fails to understand how this relates to sending a client request to the host connection manager. Specifically, step 311 is described as sending information related to an inputted transaction (i.e. the user’s PIN) to a back-

end ATM network processing center, not sending a client request indicative of a particular monetary value as is described in claims 1 and 9. Consequently, Brody fails to describe all elements of the present invention as described in claims 1 and 9. Therefore, for at least this reason, Applicant requests that the rejection of claims 1 and 9, be withdrawn and the claims be allowed.

In addition to the above described deficiencies in Brody, the Examiner concedes that Brody is further deficient with respect to claims 1 and 9 in describing the element of sending the PIN to the client terminal in response to the client request, stating that “Brody et al. does not explicitly disclose ‘sending the PIN to the client terminal in response to the client request.’” The Examiner then cites Konya to try to cure this admitted deficiency.

Applicant first notes that this deficiency is apparent in Brody because, at a minimum, Brody lacks a host connection manager or an analogous element and therefore cannot describe sending a PIN from such an element to a client terminal, either explicitly or implicitly. Moreover, Brody fails entirely to describe distribution of a PIN through a client terminal as is described in the present invention – Brody at most describes providing a partial PIN (see, e.g., Col. 3, lines 5-10) where a user provides the other half, and in any case, the partial PIN is not provided in a fashion that is the same as or similar to that of the present invention.

Applicant further asserts that Konya is similarly deficient with respect to this element. Applicant first notes that Konya is directed to transferring currency from one ATM to another or from an ATM to an account [Abstract], and Konya does not describe or suggest anything about

PIN distribution or in particular PIN distribution to a client terminal. The Examiner asserts that Konya does describe such an element of sending a PIN to a client terminal, citing Col. 11, lines 11-26. This section of Konya is listed below:

FIGS. 7A and 7B outline the procedure necessary to retrieve the currency which has been transferred. While many of the steps in this procedure are similar to those followed to perform the transfer part of the transaction, there is one key difference in retrieving the currency. It must be retrieved from an ATM. A second ATM is located and the recipient's transaction card, or second transaction card, is inserted into the card reader thereof in order to begin the session. The second ATM is in remote communication with a second computer system containing a database with information on accounts held therein. If necessary, the recipient may need to verify their authority to access the second account by providing the appropriate PIN associated with the account. Once the PIN is verified, access to the account may be granted. (emphasis added)

As described in this section, as well as the associated FIGS 7A and 7B, it is apparent that Konya says nothing more than that, if necessary for verification purposes, a user must enter a PIN to an ATM system, where the user's authority to access the account is then verified. FIG. 7A further confirms this, showing an unlabeled box that states "ENTER PIN," requesting a user to input a PIN. Unlike the instant element of claims 1 and 9 related to sending a PIN to a client terminal, the cited section of Konya describes the opposite – a user inputting a PIN (i.e. "providing the appropriate PIN") at a client terminal to be sent to a verification section.

Consequently, contrary to the Examiner's assertion, the cited section of Konya fails to describe or suggest the cited element. Moreover, Applicant is unable to find any other suggestion in Konya of providing or delivering a PIN.

Accordingly, for at least the above described reasons, neither Brody or Konya, alone or in combination, describe all elements of the present invention as described in claims 1 and 9.

Applicant therefore respectfully requests that the rejections be withdrawn and claims 1 and 9, as well as their dependent claims, be allowed.

With respect to claims 2 and 10, as discussed above, Brody fails to describe a host connection manager, or in particular a host connection manager as described in claims 1 and 9, and the Examiner fails to identify which element he believes corresponds to the claimed element. Consequently, Brody cannot describe generating a request at such a host connection manager, or in particular generating the request in response to receiving a client request at the host connection manager.

The Examiner cites Figure 3 of Brody, asserting that “when the card is read it generates a response request.” Applicant is unclear as to which step or steps of Figure 3 the Examiner is referring to, in particular since there are 16 interconnected steps in Figure 3. However, Applicant believes that the Examiner may be referring to step 303, where the input card is read at an ATM to determine whether or not it is an “input card.” If it is not, so called conventional processing is done, where nothing regarding sending or receiving a PIN is described. The Examiner further states that “when the card is read it generates a response request” [Office Action, Page 7]. Applicant notes that the Brody says absolutely nothing about “generating a response request” in conjunction with FIG. 3, or in particular generating a request for a PIN being initiated in response to receiving a client request at a host connection manager.

With respect to claims 3 and 11, where the generating is described as being in advance of the receiving of a client request at a host connection manager, Applicant first notes that, for the

reasons described previously, Brody fails to describe or suggest a host connection manager or in particular a host connection manager as is described in claims 1 and 9, and therefore Brody fails to describe this limitation. Moreover, the Examiner's rejection of claim 3 (and by implication claim 11), merely states "Figure 1," without anything further. Figure 1 of Brody is nothing more than a block diagram showing "an ATM system of the type contemplated by the invention" (Brody, Col. 4 lines 28-29 and Figure 1). Neither this figure or its associated text says anything about priorities for receiving client requests or generating a request for PINS, and the Examiner has not provided any further explanation.

Applicant respectfully notes that, in applying a rejection under 35 U.S.C. § 103, the Examiner cannot rely on generally pointing to the references, such as by merely referring to a figure of the reference, to support a claim that each limitation is taught. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In *re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974), see also MPEP § 2143.03. Consequently, establishing that all the claim limitations are taught requires that, for references like Brody, "the particular part relied on must be designated as nearly as practicable" by the Examiner; see, e.g., Rule 1.104 (c)(2). This problem with the Examiner's previous rejection was not addressed at all in the instant Office Action, with the previous basis of rejection merely reiterated verbatim. Without more, the instant Office Action has failed to meet the standard for a prima facie case of obviousness and is therefore improper. Accordingly, Applicant respectfully requests that the rejections of claims 3 and 11 be withdrawn and the claims be allowed.

With respect to claims 4 and 12, aspects of the claimed elements relate to a PIN cache in a host connection manager and storage and retrieval of one or more PINs in the cache in response to a client PIN request. The Examiner asserts that Brody teaches such elements, citing Col. 7, lines 14-25. This section of Brody was previously listed in this paper with respect to argument distinguishing claims 1 and 9. As noted previously, Brody fails to describe or suggest a host connection manager, or in particular a host connection manager as is described in claims 1 and 9, and therefore cannot describe this element. Moreover, Brody, Col. 7, lines 14-25 relate to receiving, at an ATM input, a PIN from a user – not storing and distributing PINs to users. Consequently, Brody fails to describe or suggest the elements of a host connection manager, a PIN cache, as well as storing and retrieving PINs from such a cache. Accordingly, the rejections of claims 4 and 12 are improper, and Applicant therefore respectfully requests that they be withdrawn and the claims be allowed.

With respect to claim 5, the Examiner has merely stated that the rejection is based on “Figure 1,” without saying anything further. For the same reasons provided previously with respect to claims 3 and 11, Applicant submits that this rejection is improper as failing to describe with sufficient specificity the relevant elements in Brody. Moreover, the Examiner has not addressed this issue in the instant Office Action. Therefore, Applicant respectfully submits that the rejection of claim 5 is improper and requests that the rejection be withdrawn and claim 5 be allowed.

With respect to claims 6 and 13, aspects of the claimed elements relate to a first communication protocol associated with a first network connecting a host connection manager to a server and a second communication protocol associated with a second network connecting a client terminal to the host connection manager. The Examiner asserts that Brody teaches such elements, citing Col. 5, lines 22-36. As previously described, Brody fails to describe the element of a host connection manager, or in particular a host connection manager as described in claims 1 and 9, and therefore cannot describe this element. Moreover, the cited section of Brody merely states that an ATM is connected to an "ATM Network Processing Central 13," which can be an ATM control system connecting one or more ATMs. The cited section says nothing about use of different protocols between network connections, or in particular between a client terminal and host connection manager and a host connection manager and a server. For at least these reasons, Brody fails to describe these elements of the present invention and therefore the claim rejections are improper. Accordingly, Applicant respectfully requests that the rejections of claims 6 and 13 be withdrawn and the claims be allowed.

With respect to claim 7, the Examiner again merely states "Figure 1" as the basis of the rejection. For the same reasons provided previously with respect to claims 3 and 11, Applicant submits that this rejection is improper as failing to describe with sufficient specificity the relevant element in Brody. Moreover, the Examiner has failed to address this issue in the instant Office Action. Accordingly, Applicant respectfully submits that the rejection of claim 7 is improper and respectfully requests that the rejection be withdrawn and claim 7 be allowed.

With respect to claim 8 and 14, aspects of the claimed elements relate to a system where a client terminal does not store an inventory of PINs, but wherein a PIN may be sent to the client terminal in response to a client request. The Examiner asserts that Brody teaches such an element, citing merely to the Abstract, i.e., stating “(Abstract) – temporary PIN is used.” Applicant respectfully submits that the Examiner misconstrues Brody in view of the present invention. Specifically, aspects of the present invention are directed towards delivery of a PIN to a client terminal, where an inventory of PINs are not stored at the client terminal. While Brody may or may not describe or suggest delivery of a partial PIN to a user, neither the cited section, or any other section, describes or suggest storing an inventory of PINs that can be delivered to a user, irrespective of where the inventory may be stored. Consequently, Brody fails to describe this element, and therefore the rejection of claims 8 and 14 is improper. Accordingly, for at least this reason, Applicant respectfully requests that the rejections of claims 8 and 14 be withdrawn and the claims be allowed.

With respect to claims 9-15, the Examiner has made an omnibus rejection of these system claims based assertedly on similarity to method claims 1-8. Applicant respectfully notes that aspects of systems claims 9-15 differ from method claims 1-8, and such omnibus rejections are improper without particularly pointing out the distinct elements of the claim as identified by the Examiner in the references. Specifically, in both the instant Office action as well as the previous non-final Office Action, the Examiner has stated nothing in the substantive Detailed Action regarding the basis for the rejection of other elements or limitations of claims 9-15 beyond those described in method claims 1-8. For example, claim 15 describes a system in accordance with

claim 9, wherein the host connection manager does not store an inventory of PINS. The Examiner has not provided any reasons for rejecting claim 15, and in particular where this element is shown in either Brody or Konya. Moreover, as noted previously, Brody lacks an element of a host connection manager as described in claim 9, and therefore cannot describe such storage, or lack thereof, in a host connection manager.

Applicant notes that claims 1-8 and 9-15 each include different scopes of protection, and Applicant respectfully notes that, per MPEP § 707.07(d), all grounds for rejection must be “fully and clearly stated.” Such omnibus rejections are improper under MPEP § 707.07(d), and therefore, to the extent that the Examiner believes that these claims are not patentable, Applicant respectfully requests the Examiner to provide a detailed discussion as to the manner in which the cited art reads on each element of these claims in a new, non-final Office Action.

For at least the above described reasons, neither Brody or Konya, alone or in combination, describe all of the elements of the present invention as described in claims 1-15,. Accordingly, Applicant respectfully requests that the rejections be withdrawn and claims 1-15 be allowed.

New Claims

Applicant has added new dependent claims 27-33 as fully supported by the Specification and Drawings of the instant application as filed. For at least the above-described reasons,

Applicant respectfully submits that new claims 27-33 are also allowable, and Applicant therefore requests that these claims also be allowed.

Concluding Comments

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue, or comment does not signify agreement with or concession of that rejection, issue, or comment. In addition, because the arguments made are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim except as specifically stated in this paper.

Applicant respectfully requests consideration of the remarks herein prior to further examination of the above-identified application. The undersigned would of course be available to discuss the present application with the Examiner if, in the opinion of the Examiner, such a discussion could lead to resolution of any outstanding issues.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 50-1283.

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COOLEY GODWARD KRONISH LLP
ATTN: Patent Group
777 6th Street NW, Suite 1100
Washington, DC 20001

Tel: (858) 550-6241
Fax: (202) 842-7899

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Respectfully submitted
COOLEY GODWARD KRONISH LLP

By: 

Steven C. Tietsworth
Reg. No. 59855